

REMARKS

By virtue of this amendment, Claim 15 is cancelled and new claim 44 is added to recite a pharmaceutical composition containing a compound according to claim 18. Following the entry of the amendment, claims 18-25, 27, 29-31 and 44 are pending for further consideration. Applicants submit that no new matter is added.

Rejections under 35 USC 103

Claims 15, 18, 19, 20, 21, 22, 24 and 25 were rejected under 35 USC 102(b) as being obvious over Hcaplus 1976:30139 and further in view of Patani et al. Applicants respectfully traverse the rejection.

Claims 19-22, 24, 25 and 44 depend from claim 18. Since the compounds disclosed in Hcaplus have been excluded from the compounds as defined by Formula I by way of provisos in claim 18, it is respectfully submitted that the subject matter of claim 18 and the claims depending therefrom are novel.

Further, it is respectfully submitted that the claims are novel in view of the relied upon art. Specifically, Hcaplus is a literature reference purely concerned with a synthetic method and is not remotely concerned with the biological activity of any of the synthesized compounds, much less with their activity

on the androgen receptor. Therefore, Hcaplus is neither in the field of the applicant's endeavor nor is it reasonably pertinent to the problem with which the inventor was concerned, namely the provision of androgen receptor modulators. Thus, there is no reason, and the Office Action has provided no reason, as to why the skilled person would be motivated to select the chosen reference from the myriad of prior art documents available in the general field of organic chemistry as a particularly promising starting point for designing a new class of androgen receptor modulators. It therefore appears that the Office Action's conclusions on obviousness have been arrived at using hindsight, rather than through a properly reasoned basis using a document from the relevant technical field as a starting point.

Moreover, the instant application provides biological data showing that a representative selection of Example compounds of the invention have the desired androgen receptor modulating activity (see page 29 of the published US patent application). Such androgenic activity, as evidenced by binding assay IC₅₀ values of less than 500 nM and transactivation assay IC₅₀ values of less than 500 nM, demonstrates that the claimed compounds do indeed show unexpected results in view of the Hcaplus (1976) prior art compounds. Indeed, the Hcaplus document provides no teaching or suggestion that any compounds disclosed therein have

any particular biological activity. Accordingly, Applicants respectfully submit that the rejection is untenable and should be withdrawn.

Claim Objections

Claims 23, 29, 30, and 31 were objected to because they are based on rejected claim 18.

As discussed above in detail in the context of the \$103 rejection, the rejection to claim 18 is untenable. Accordingly, it is respectfully submitted that the objections applied to claims 23, 29, 30 and 31 are overcome.

In view of the above, it is believed that the instant claims are in condition for allowance. Accordingly, an early receipt of a Notice of Allowance is respectfully requested.

If the Examiner has any questions concerning this application, the Examiner is encouraged to contact the undersigned attorney.

Please charge any fees due with this response to Deposit
Account 23-1665 under Customer Number 27267.

Respectfully submitted,

HENRIK JERNSTEDT ET AL.

By Todd E. Garabedian
Todd E. Garabedian, Ph.D.
Registration No. 39,197
Attorney for Applicants

WIGGIN and DANA LLP
One Century Tower
New Haven, CT 06508
Telephone: (203) 498-4400
Facsimile: (203) 782-2889

Date: 23 June 2000

167778\2387643.1